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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,453	11/05/2001	Bernd Fabry	H 4132 PCT/US	1938
23657	7590	03/24/2004	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/009,453

### Applicant(s)

FABRY ET AL.

### Examiner

Lauren Q Wells

### Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9,10,12-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1617

### **DETAILED ACTION**

Claims 9-10, 12-16, and 18-24 are pending. The Amendment filed 11/12/03, amended claims 9 and 15, cancelled claims 11 and 17, and added claims 21-24.

The Amendment filed 11/12/03, wherein claims 9 and 15 are amended and 11 and 17 are cancelled, are persuasive to overcome the 35 USC 102(b) and 103 rejections in the previous Office Action. However, Applicant's amendment filed 11/12/03, necessitated the following new grounds of rejection (see below).

Regarding Applicant's inquiry as to a refund for the Notice of Appeal fee, the Examiner respectfully directs Applicant to the MPEP and to the Customer Service Center at 571-272-1600.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10, 12-16, 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. in view of Miles (2,456,437).

The instant invention is directed to a composition comprising an active ingredient selected from cosmetically or pharmaceutically active ingredients, and mixtures thereof, and metal soap particles having a mean diameter of from 10-300nm, wherein the metal soap nanoparticles are coated with a coating compound selected from a protective colloid, an emulsifier, and mixtures thereof, and methods thereof.

Art Unit: 1617

Ansmann et al. exemplify a sunscreen composition comprising octyl methoxycinnamate (cosmetically active ingredient) and 1% zinc stearate (metal soap), wherein Col. 3, lines 1-14, teach zinc stearate as a particle having a mean diameter of less than 100nm and preferably between 5 and 50nm. See Col. 8, lines 30-65. US 6,280,712 is relied upon as a translation for WO 99/11235. The reference lacks coatings.

Miles teaches that soap particles coated with an organic material such as starch and gums (col. 2, line 50-col. 3, line 1) overcome the disadvantages of dusting and agglomeration. The reference exemplifies a soap particle coated with 0.1% coating (Col. 3, lines 69-70) and teaches that the organic coating material applied to the soap particles is in the range of 0.01-10% (col. 4, line 68-Col. 5, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the zinc stearate taught by Ansmann et al. with the coating agents taught by Miles because of the expectation of achieving homogeneous metal soap compositions that do not agglomerate.

Claims 15-16 and 18-20 are directed to a method of enhancing the stability, opacity and consistency of a composition comprising adding metal soap nanoparticles having a mean diameter of from 10-300nm. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as

Art Unit: 1617

instantly claimed product. The prior art teaches metal soap particles as ingredients in cosmetic compositions, which would inherently enhance the stability, opacity and consistency of a cosmetic composition as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

### ***Response to Arguments***

Applicant argues, “the problem associated with Miles’ teaching is that it is silent with respect to the potential for using organic materials to coat inorganic soap particles such as the claimed metal soap particles”. This argument is not persuasive. It is respectfully pointed out that a reference is not limited to its preferred embodiments or examples. While Miles’ exemplifies inorganic soap particles, he teaches that his invention is for soaps, wherein both organic and inorganic forms of soaps are encompassed by this disclosure.

Applicant argues, “even a person of ordinary skill in the art having both the Ansmann and Miles references in front of them, would not necessarily be motivated to apply the organic material of the Miles reference onto the metal soaps of the Ansmann reference, since there is no teaching or suggestion that this can be successfully done”. This argument is not persuasive. It is respectfully pointed out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In the instant case, given the benefits taught by Miles’, one of ordinary skill in the art would be motivated to coat the soap particles of Ansmann because of the expectation of decreasing dusting and agglomeration.

Art Unit: 1617

Applicant argues, “there is not teaching or suggestion in either reference that the problem address by the Miles reference, i.e., elimination of dust particles, is also a problem experienced by metal soaps”. This argument is not persuasive. First, the Examiner respectfully points out that Miles teaches metal soaps. Second, it is respectfully pointed out that the metal soaps of Ansmann are nanoparticles and that all particles of such a small size range are subject to forming dust particles. Additionally, it is respectfully pointed out that agglomeration is also relied upon to provide motivation to the coat the particles of Ansmann with the coatings of Miles’.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**